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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ADAM G. SOUTHAM and JEFFREY SVEN GUSTAFSON

Appeal 2009-011883
Application 09/659,664
Technology Center 3600

Before, HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

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STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's non-final rejection of claims 1, 2, and 5-60, the only claims pending in the application on appeal. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for allowing syndicated radio and television content to be included in Internet transmissions while protecting the interests of advertisers in local radio and television markets. (Specification 2:26-28).

Representative claim 1 is reproduced below.

1. A system for exposing Internet users to advertisements together with the distribution of media content in a manner which is germane to conventional syndicated broadcast agreements, comprising:

 a processor;

 a memory device coupled to the processor; and

 software operable on the processor and memory device to cause the system to:

 maintain a database of syndicated media content, wherein the syndicated media content is subject to distribution restrictions;

 obtain a user specific set of data prior to distributing a media package to an Internet user, wherein the user specific set of data includes localizing data;

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select a number of advertisements from a data bank containing a plurality of advertisements based on the localizing data of the user specific set of data and the syndicated media content distribution restrictions; and

combine the selected number of advertisements with a requested set of syndicated media content to form the media package.

THE REJECTION

The Examiner relies upon the following prior art:

Logan	US 5,721, 827	Feb. 24, 1998
Ginter	US 5,892,900	Apr. 6, 1999

“Internet Distributors signs international syndication agreement with IEE Network,” PR Newswire, p012LAW064, Jan. 21, 1998 (“Internet Distributors”)

The following rejection is before us for review.

The Examiner rejected claims 1, 2, and 5-60 under § 103(a) as unpatentable over Logan in view of Ginter and further in view of Internet Distributors.

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 1, 2, and 5-60 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Logan in view of Ginter and Internet Distributors on the grounds that a person with ordinary skill in the art would understand that because Logan discloses distributing syndicated content combined with advertisements which are selected based on localizing data, such as ZIP code, and because Ginter discloses distributing

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syndicated content while providing mechanisms to adhere to licensing restriction agreements, that the combination discloses selecting advertisements based on localizing data of the user specific set of data and the syndicated media content distribution restrictions?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Logan discloses customizing advertising, combined with programming content, based on data supplied by the user in that:

... an interested subscriber invokes programming services by first supplying personal information and initial programming preferences during an account initialization procedure. Preferably, as explained in more detail later, account initialization is accomplished by presenting the subscriber with HTML forms to complete and submit to CGC script programs which execute on the server to post subscriber supplied information into an initial user dataset. Based on the information supplied by the user, the server then compiles one or more files for downloading to the subscriber at step 207 which include programming and advertising segments as well as additional data and utility programs needed by the player 103 to begin operation. (col. 6 ll. 48-60).

2. Logan discloses selecting advertisements based on a user specific set of data, which can include a zip code, in that "personal data describing each subscriber's subject matter interests is available, along with personal data (age, marital status, zip code, etc.), particular advertising segments may be directed to

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only those subscribers having a likely interest in the goods or services advertised. (col. 9. ll. 39-43).

3. Appellants acknowledge that “...Logan includes selecting advertisements based on a user specific set of data, which can include a zip code....” (Appeal Br. 11).

4. The Specification describes syndicated media content in the context of, “... the set of syndicated media content includes media content selected from the group consisting of syndicated radio content, syndicated print content, and syndicated television content.” (Specification 10: 4-6).

5. Appellants’ Specification states, “[a]s used in this invention syndicated content is intended to include any media content having a restricted distribution.” (Specification 10: 6, 7).

6. Ginter discloses revenue generating syndicated media content in the form of television, cable, satellite transmissions, motion picture recordings, book, magazine, and newspaper publications, and advertising stating:

Today, virtually anything that can be represented by words, numbers, graphics, or system of commands and instructions can be formatted into electronic digital information. Television, cable, satellite transmissions, and on-line services transmitted over telephone lines, compete to distribute digital information and entertainment to homes and businesses. The owners and marketers of this content include software developers, motion picture and recording companies, publishers of books, magazines, and newspapers, and information database providers. ... The present invention can materially enhance the revenue of content providers,

lower the distribution costs and the costs for content, better support advertising and usage information gathering, and better satisfy the needs of electronic information users. (col. 1, ll. 52 – col. 2, ll. 4).

7. Ginter discloses within a Virtual Distribution Environment (VDE), the use of syndicated media content (FF 5) having distribution restrictions in that:

VDE participants in a commercial value chain can be "commercially" confident (that is, sufficiently confident for commercial purposes) that the direct (constituent) and/or "extended" electronic agreements they entered into through the use of VDE can be enforced reliably. These agreements may have both "dynamic" transaction management related aspects, such as content usage control information enforced through budgeting, metering, and/or reporting of electronic information and/or appliance use, and/or they may include "static" electronic assertions, such as an end-user using the system to assert his or her agreement to pay for services, not to pass to unauthorized parties electronic information derived from usage of content or systems, and/or agreeing to observe copyright laws. (col. 14 ll. 49-62).

8. The Examiner found that one of ordinary skill in the art would be motivated to combine the licensing restrictions of Ginter with Logan, because such licensing restrictions are a common limitation in the field of content distribution (Answer 4), and because licensing agreements recognizing these restrictions are a common means to enable protecting property rights concerning the distributed content (Answer 6).

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ANALYSIS

We affirm the rejection of claims 1, 2, and 5-60.

Claims 1, 19, 25, 30, 51, and 56

Initially, we note that the Appellants argue these claims together as a group. Correspondingly, we select representative claim 1 to decide the appeal of these claims, remaining claims 19, 25, 30, 51, and 56 standing or falling with claim 1.

Appellants argue that each of Logan, Ginter, and Internet Distributors “fails to teach or suggest selecting advertisements based on ‘localizing data of the user specific set of data *and the syndicated media content distribution restrictions*’ as in claim 1.” (emphasis original). (Appeal Br. 11).

We disagree with Appellants. Logan discloses selecting advertisements based on a user specific set of data, which can include a zip code as part of the user specific data (FF 2). That is, Logan explicitly discloses that “personal data describing each subscriber’s subject matter interests is available, along with personal data …[including zip code, and thus] … advertising segments may be directed to only those subscribers having a likely interest in the goods or services advertised (FF 2). Accordingly, we find that Logan meets the claim requirement of selecting advertisements based on localizing data because Logan discloses using a ZIP code to compile advertising segments for targeted distribution to a user in the ZIP code area.

The Specification does not define the phrase “syndicated media content distribution restrictions.” The Specification at best describes examples of syndicated media content as print, television, and radio content (FF 4), which has

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restrictions on distribution (FF 5). We find that Ginter discloses like content, such as television, cable, satellite transmissions, motion picture recordings, book, magazine, and newspaper publications which are similar to that disclosed in the Specification as being syndicated (FF 4). Such content in Ginter is further disclosed as being subject to distribution restrictions (FF 7). Therefore, we find that the required claim language is met, at least by the combination of Logan and Ginter.

Claims 9, 39, 45, 47 and 48

Appellants next argue claims 9, 39, 45, and 47-48 separately because these claims additionally require *selecting an appropriate geographic group of advertisements based on the obtained localizing data in relation to the distribution restrictions of the syndicated content.*

We select representative claim 9 to decide the appeal of these claims, remaining claims 39, 45, 47, and 48 standing or falling with claim 9.

Appellants argue the combination of references fails to teach or suggest this feature. (Appeal Br. 12).

We disagree with Appellants because Logan discloses advertising segments, or groups, derived from user-provided localizing data which can be based on ZIP code (FF 2). We find that Logan meets the claim element of geographic groups when advertising segments are grouped by a common ZIP code.

Appellants' next argue that "one of skill in the art would not have a reasonable expectation of success in reaching the invention(s) of the present claims when combining Internet Distributors with Logan and Ginter." (Appeal Br. 14).

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We disagree with Appellants because obviousness does not require absolute predictability of success, only that there be a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 904 (Fed. Cir. 1988). We find that because Logan and Ginter each describe mechanisms to distribute licensed content to users (FF 1, 5), their combination would constitute a reasonable likelihood of success.

Appellants' finally argue that the rejection is based on impermissible hindsight, specifically because the references do not provide a motivation to solve the problem solved by the claimed invention. (Appeal Br. 15).

To the extent Appellants seek an explicit suggestion or motivation in the reference itself; this is no longer the law in view of the Supreme Court's recent holding in *KSR* at 419. Since the Examiner has provided some articulated reasoning with some rational underpinning for why a person with ordinary skill in the art would modify Logan with the teachings of Ginter and Internet Distributors, e.g., because licensing restrictions are a common means to protect content distribution (FF 8), Appellants' argument is not persuasive as to error in the rejection.

We also affirm the rejections of dependent claims 2, 5-8, 10-18, 20-24, 26-29, 31-38, 40-44, 46, 49, 50, 52-55, and 57-60, since Appellants have not challenged such with any reasonable specificity (see *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987)).

CONCLUSION OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1, 2, and 5-60 under 35 U.S. C. § 103(a).

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DECISION

The decision of the Examiner to reject claims 1, 2, and 5-60 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JRG

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